

REMARKS

Claims 11 and 17 are canceled without prejudice, and therefore claims 8 to 10, 12 to 16 and 18 to 19 are currently pending in the present application.

It is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Claims 8 to 12 and 14 to 18 were rejected under 35 U.S.C. § 103(a) as unpatentable over Morsch, DE 3425235.

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. *See KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that "rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

While the rejections may not be agreed with, to facilitate matters, claims 11 and 17 have been canceled without prejudice, since their features have been included in their respective base claims 8 and 14. Accordingly, claims 8 and 14, as presented, do not provide that the active rotary speed sensor is designed for a lower operating voltage than an electrical system voltage of the vehicle.

As to the continued assertions that the rotary sensor features are merely intended use, it is noted that claims 8 and 14 positively recite the features and structure as to a rotary sensor both in the preamble and in the body of the claim, so that the features are plainly not an intended use as conclusorily asserted.

It is also respectfully submitted that any review of the applied reference makes plain that they do not disclose nor suggest an electronic circuit configuration for connecting at least one active rotary speed sensor of a vehicle via an assigned signal conditioning circuit to a control unit for further signal processing of a rotary speed signal wherein the active rotary speed sensor is designed for a lower operating voltage than an electrical system voltage of the vehicle, as provided for in the context of the claimed subject matter.

In particular, the Morsch reference does not disclose nor suggest a circuit arrangement for protecting an active rotary speed sensor of a vehicle against overvoltage (as conceded in the Office Action at page 2), a signal conditioning circuit for connecting the active rotary speed sensor of a vehicle to a control unit for further signal processing or the feature wherein the active rotary speed sensor is designed for a lower operating voltage than an electrical system voltage of the vehicle. Contrary to the conclusory assertions of the Final Office Action, Morsch does not in any way disclose nor suggest a sensor configured for a lower operating voltage than the electrical system voltage of the vehicle, as provided for in the context of the claimed subject matter. In particular, Morsch does not even disclose a sensor and certainly does not disclose a sensor configured to operate at a lower voltage than the electrical system of the vehicle as provided in claims 8 and 14 as presented.

The Final Office Action conclusorily asserts that it is well known in the art that electrical sensors need overvoltage protection, that all of the claim elements are well known in the art and one of skill in the art could have combined the elements as claimed and the combination would have yielded predictable results, and that the operating voltage of the sensor that Morsch does not disclose can be any desired voltage. (Office Action at pages 3 and 4). Any Official Notice is respectfully traversed to the extent that it is maintained and it is requested that the Examiner provide specific evidence to establish those assertions and/or contentions that may be supported by that Official Notices under 37 C.F.R. § 1.104(d)(2) or otherwise. In particular, it is respectfully requested that the Examiner provide an affidavit and/or that the Examiner provide published information concerning these assertions. This is because the § 103 rejections are apparently being based on assertions that draw on facts

within the personal knowledge of the Examiner, since no support was provided for these otherwise conclusory and unsupported assertions. (See also MPEP § 2144.03).

Still further, the Final Office Action does not present a prima facie case of obviousness consistent with the Supreme Court's KSR decision and consistent with the provisions set forth in M.P.E.P. § 2142 et seq. A rejection under 35 U.S.C. § 103(a) cannot be sustained with mere conclusory statements, since there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. KSR International Co. v. Teleflex Inc., 82 U.S.P.Q.2d 1385, 1386 (2007).

Among the rationales that may support a conclusion of obviousness are: (a) combining prior art elements according to known methods to yield predictable results; (b) simple substitution of one known element for another to obtain predictable results; (c) use of known technique to improve similar devices (methods, or products) in the same way; (d) applying a known technique to a known device (method, or product) ready for improvement to yield predictable results; (e) choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success; (f) known work in one field of endeavor that may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art; and (g) some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention. The Office Action does not adequately support the rationales upon which the present rejection is based.

While the Final Office Action appears to be relying on the combining prior art elements according to known methods to yield predictable results rationale, the Final Office Action provides no proper basis for the assertion that the operating voltage of a sensor added to the Morsch circuit can be any desired voltage. The Office however has not shown how this could be done and has not provided any teaching or motivation in the Morsch reference that would suggest making the claimed combination. As explained above, an obviousness rejection cannot be sustained with mere conclusory statements.

Accordingly, claims 8 and 14, as presented, are allowable, as are their dependent claims.

In view of all of the foregoing, withdrawal of the rejections is respectfully requested.

Claims 13 and 19 were rejected under 35 U.S.C. § 103(a) as unpatentable over Morsch in view of US 2004/0016461 (Qu et al.).

Claims 13 and 19 ultimately depend from claims 8 and 14 and are therefore allowable for the same reasons, since Qu does not cure – and is not asserted to cure -- the critical deficiencies of the Morsch reference. Accordingly, claims 13 and 19 are allowable.

In view of the foregoing, withdrawal of the rejections is respectfully requested.

Accordingly, claims 8 to 10, 12 to 16 and 18 to 19 are allowable.

Conclusion

It is therefore respectfully submitted that all of claims 8 to 10, 12 to 16 and 18 to 19 are allowable. It is therefore respectfully requested that the rejections (and any objections) of these claims be withdrawn, since all issues raised have been addressed and obviated. An early and favorable action on the merits is respectfully requested.

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Respectfully submitted,

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